

REMARKS

I. Introduction

The Current Action has rejected claims 1-18 under 35 U.S.C. §103(a). The arguments below fully traverse these rejections, and the Applicants respectfully ask the Examiner to withdraw them. In addition, this response amends claims 1 and 15 in order to more clearly describe the claimed invention. No new matter has been added, and claims 1–18 remain pending in the present application.

II. Rejections

Claims 1, 2, 6–10, and 13–18 have been rejected as obvious in light of a combination of *Tal*, U.S. Patent No. 6, 535, 856 (hereinafter *Tal*), and *Nozue et al.*, U.S. Patent No. 5,890,189 (hereinafter *Nozue*). The Applicants respectfully assert, however, that the Current action has failed to establish a prima facie case for rejecting these claims. In order to establish a prima facie case for obviousness, M.P.E.P. §2143 requires a rejection to meet three basic criteria. First, the proposed combination of references must teach or suggest each and every limitation of the claims rejected using that combination. Second, the rejection must demonstrate some suggestion or motivation to combine reference teachings either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. Third, the combination used must have inspired a reasonable expectation of success. Without conceding that the second and third criteria have been met, the Applicants respectfully submit that the Examiner's proposed combination does not teach or suggest all of the limitations of claims 1, 2, 6–10, and 13–18.

Claim 1 recites “a memory storing a plurality of payment and non-payment applications.” The Current Action does not specifically locate such a memory in the proposed combination, but rather appears to use database 34.n of *Tal* FIGURE 3 as an equivalent. However, without conceding that database 34.n performs the “regulating and enforcing open account payments” functions indicated by the Current Action at page 2, the Applicants respectfully assert that database 34.n is not “a memory storing a plurality of payment and non-payment applications.” In fact, database 34.n does appear to store applications at all, but rather acts as a mere storehouse for account information. *See Tal*

Column 4, lines 15–40. Although the Current Action does not rely on it to do so, *Nozue* does not appear to teach or suggest this limitation either. Therefore, the combination of *Tal* and *Nozue* does not teach or suggest every limitation of claim 1, and the Current Action fails to establish a prima facie case. The Applicants respectfully ask the examiner to withdraw the rejection of claim 1.

Claim 8 recites “storing a plurality of payment and non-payment applications in separate memory locations within said terminal.” Again, the Current Action does not appear to specifically address this limitation, but rather, seems to imply that database 34.n in FIGURE 3 of *Tal* incorporates this limitation as well. The Applicants respectfully assert, however, that no element of *Tal* performs the action of storing a plurality of payment and non-payment applications. Certainly database 34.n does not, as it appears to act as a mere storehouse for accounting information. Although the Current Action does not rely on it to do so, *Nozue* does not appear to teach or suggest this limitation either. Therefore, the combination of *Tal* and *Nozue* does not teach or suggest every limitation of claim 8, and the Current Action fails to establish a prima facie case. The Applicants respectfully ask the examiner to withdraw the rejection of claim 8.

Claim 15 recites “a terminal for accepting data from a credit card in conjunction with point of sale purchase information.” This limitation is not addressed by the Current Action either, and the Applicants can find no portion of *Tal* that could be considered similar. Although the Current Action does not rely on it to do so, *Nozue* does not appear to teach or suggest this limitation either. Therefore, the combination of *Tal* and *Nozue* does not teach or suggest every limitation of claim 15, and the Current Action fails to establish a prima facie case. The Applicants respectfully ask the examiner to withdraw the rejection of claim 15.

Claims 2, 6, 7, 9, 10, 13, 14, and 16–18 depend either directly or indirectly from claims 1, 8, or 15. Although claims 2, 6, 7, 9, 10, 13, 14, and 16–18 all recite limitations that make them patentable in their own right, they are at least patentable for depending from a patentable base claim. Therefore, the Applicants respectfully ask the Examiner to withdraw the rejections to claims 2, 6, 7, 9, 10, 13, 14, and 16–18 as well.

Claims 3–5, 11, and 12 are rejected as obvious in light of *Tal*, *Nozue*, and in further light of *Ishiguro et al.*, U.S. Patent No. 5,446,796 (hereinafter *Ishiguro*). However, claims 3–5 depend from claim 1, and claims 11 and 12 depend from claim 8. Thus each of claims 3–5, 11, and 12 inherits all of the limitations of its respective base claim. As argued above, the combination of *Tal* and *Nozue* does not teach or suggest “a memory storing a plurality of payment and non-payment applications,” as recited by claim 1. Nor does the combination teach or suggest “storing a plurality of payment and non-payment applications in separate memory locations within said terminal,” as recited by claim 8. Although the Current Action does not rely on it to do so, *Ishiguro* does not appear to teach or suggest these limitations either, thus the combination of *Tal*, *Nozue* and *Ishiguro* does not teach or suggest every limitation of claims 3–5, 11, and 12. Therefore, the Current Action fails to establish a prima facie case, and the Applicants respectfully ask the examiner to withdraw the rejection of claims 3–5, 11, and 12.

Conclusion

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Applicants believe no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 08-2025, under Order No. 10013451-1, from which the undersigned is authorized to draw.

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV482737665US in an envelope addressed to: Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Date of Deposit: August 23, 2004

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